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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/530,609

10/19/2005

Brian Augustine Boserio

Fisher-G

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05/28/2008

KRUGLIAK, WILKINS, GRIFFITHS & DOUGHERTY CO, LPA

4775 MUNSON STREET N.W.

P.O. BOX 36963

CANTON, OH 44735-6963

EXAMINER

HARTMANN, GARY S

ART UNIT

PAPER NUMBER

3671

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|--------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/530,609 | BOSERIO, BRIAN AUGUSTINE | |
| | Examiner | Art Unit | |
| | Gary Hartmann | 3671 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-23 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 18 is objected to because of the following informalities: “tile” in line 1 should be --a tile-- and “a tile” in line 3 should be --said tile--, since claim 1 provides antecedent basis for this tile. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karanikas (U.S. Patent Des. 379,670) in view of Koket (U.S. Patent 6,699,553).

Karanikas discloses stone elements bonded to and extending above a base (Figures 2, 4 and 6). The elements are of differing shape and size. The manner in which the elements are connected to the base is not disclosed as this is a design patent; therefore, this connection is left to one skilled in the art. Koket teaches that it is advantageous to embed an element into a base (Figure 4) in order to obtain a structure more resistant to temperature changes. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have embedded the elements of Karanikas in the manner of Koket.

Regarding claims 2 and 3, at least part of the base extends beyond the outer stone elements. It also appears that the entire base is wider than the stone elements. Note the 112 2nd rejection regarding these claims as discussed above.

While not objected to, it is noted that claim 4 recites essentially nothing, since the base can be of any shape. Clearly, the shape of the prior art is "suitable."

While the material is not disclosed, the thickness of the base alone is sufficient to fall within the broadly recited phrase of reinforcing material.

Claims 1-10 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas (U.S. Patent 5,470,623) in view of Koket (U.S. Patent 6,699,553).

Lucas discloses stone elements (Figures 1-3) bonded to and extending above a backing layer (2). The elements are of different size but the shapes are the same; however, the examiner takes official notice that it is well known to use different shaped stones in order to obtain a desired appearance. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted at least some of the squares of Lucas with other shapes. Koket teaches that it is advantageous to embed an element into a base (Figure 4) in order to obtain a structure more resistant to temperature changes. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have embedded the elements of Lucas in the manner of Koket.

Regarding claims 2 and 3, the backing layer extends beyond some of the edges of the stone elements. This is all that is needed to meet claim recitations. Also note the 112 2nd rejection, above.

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Regarding claim 5, a projection and recess is a common means of connection. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used this means of connection in order to facilitate connection between adjacent devices, as deemed suitable in a particular application.

The backing material is a flexible plastic mesh. This meets the recitations of claims 7-10 and 21-23.

Regarding claim 5, a projection and recess is a common means of connection. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used this means of connection in order to facilitate connection between adjacent devices, as deemed suitable in a particular application.

Because it is a design patent, Karanikas is silent with respect to materials of construction; thereby leaving the decision to one skilled in the art. The examiner takes official notice that the claimed materials are well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the materials of any of claims 7-9 and 23 in order to obtain a product suitable for use in a particular application.

Regarding method claims 18-20, Karanikas does not discuss installation of the tiles; thereby leaving that step to one skilled in the art.

Regarding claim 18, because it is standard practice to use a grouting composition in tile installation, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a grouting composition with Karanikas in order to obtain a durable finished surface.

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Regarding claims 19 and 20, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have positioned the tiles adjacent one another in the manner claimed in order to finish a surface of greater than a single tile dimension.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Karanikas/Koket or Lucas/Koket as applied above, and further in view of Brown (U.S. Patent 6,643,667).

Brown teaches optionally including a base which extends beyond a decorative surface (Figure 5) to be useful in some applications. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have extended the base of either Karanikas or Lucas as deemed best suited for a particular application.

Response to Arguments

Applicant's arguments filed 7 December 2007 have been considered but are moot in view of the new grounds of rejection. Koket teaches embedding elements and provides clear motivation for having done so. There is nothing in the structures of either Karanikas or Lucas which would have prevented the addition of the portion of Koket which enables this embedding.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 571-272-6989. The examiner can normally be reached on Tuesday through Friday, 9am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary Hartmann/
Primary Examiner, Art Unit 3671